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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/913,218	09/08/1997	FUMIE SATO	171-583P	5490
2292	7590	05/20/2004	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			NAZARIO GONZALEZ, PORFIRIO	
			ART UNIT	PAPER NUMBER
			1621	

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

08/913,218

Applicant(s)

SATO, FUMIE

Examiner

Porfirio Nazario-Gonzalez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3, 4 and 8-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-21, 23, 25, 27-30, 33-35 and 37-40 is/are allowed.
- 6) ☒ Claim(s) 3, 4, 8-10, 22, 24, 26, 31, 32, and 36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

**DETAILED ACTION*****Response to Arguments***

1. Applicant's arguments, see Supplemental Reply, filed January 20, 2004, with respect to claims 3, 4, and 8-40 rejected under 35 U.S.C. 102(b) as being anticipated by any of Nakagawa et al. and Kasatkin et al. have been fully considered and are persuasive in view of enclosed verified English translation of Priority document. The rejections of claims 3, 4, and 8-40 have been withdrawn.
2. Applicant's arguments filed January 20, 2004 traversing the rejection of claims 3, 4, and 8-40 rejected under 35 U.S.C. 102(b) as being anticipated by any of Nudenberg et al. (U.S. Pat. No. 3,424,736), GB '467, WO '567, GB '031, GB '434, FR '571, and EP '120, all cited by Applicants, have been fully considered but they are not persuasive. Applicants argues that the instant method of making claims are not anticipated by the above cited references because all of them fail to recite the intended use language in the instant claims, specifically the use of the catalyst made by the claimed process for the reaction between a compound having a carbon-carbon unsaturated bond and a compound having an electrophilic functional group or an electrophilic reagent (in the case of the WO '567 rejection) or the exclusion of polymerization reactions (in the case of Nudenberg et al. (U.S. Pat. No. 3,424,736), GB '467, GB '031, GB '434, FR '571, and EP '120 rejections). The examiner disagrees with Applicants' argument. The instant claims are directed to a process of making a titanium catalyst comprising reacting a titanium compound of the formula  $TiX^1X^2X^3X^4$  with a Grignard reagent of the formula  $R^1MgX^5$ . The preamble language is directed to the intended use of the catalyst made by the claimed method and is not a limitation of the claimed method. MPEP § 2111.02. "If the body of a claim

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fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999). See also *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997) ("where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation"). For example, *Nudenberg et al.* (U.S. Pat. No. 3,424,736), discloses the reaction between dodecyl magnesium bromide or butyl magnesium bromide (a Grignard reagent) and titanium tetraiodide (TiI<sub>4</sub>) to produce a catalyst precursor which fully anticipates the claimed method. See Examples 1 and 8. Thus, claims 3, 4, 8-10, 22, 24, 26, 31, 32, and 36 stand rejected.

***Allowable Subject Matter***

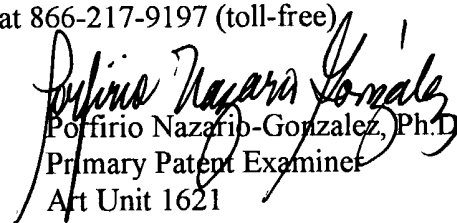
3. Claims 11-21, 23, 25, 27-30, 33-35 and 37-40 are allowed over the prior art of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Porfirio Nazario-Gonzalez whose telephone number is 571-272-0641. The examiner can normally be reached on Mon.-Fri. (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Porfirio Nazario-Gonzalez, Ph.D.  
Primary Patent Examiner  
Art Unit 1621

PNG

May 15, 2004